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EXAMINER

PENDERGRASS, KYLE M

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/941,065	SIMPSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kyle M Pendergrass	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/01</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 8, on page 30, line 1, the claim language is missing the item that is being "caused."

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-3, 7-16, 18-20, 25-27, & 29-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Arledge, Jr. et al. (US 6 535 294).**

Regarding claim 1, **Arledge et al.** teach a method comprising:

causing, via at least one network service (*column 7:lines 30-32, web service to include multiple services*), a user interface (*fig 10, layout tool applet window 330*) to be presented on a client device

(*fig 1, client 101*), the user interface being configured to enable a user to select imaging data from a Web-accessible personal imaging repository (*column 16:lines 7-12, user selects graphic images and art work uploaded by the user's computer to the repository*);

receiving, via said at least one network service, a user selection of imaging data from the personal imaging repository (*column 16:lines 7-12, user selects data available in system from list of documents in repository*);

receiving, via said at least one network service (*fig 10 7 column 15:lines 49-51, "realtime" design layout applet*), user input for incorporating the imaging data into a composition document (*column 15:lines 63-64, a desired design layout is defined, and, column 16:lines 7-19, data on repository selected to be added to layout & column 16:lines 13-19, composition document is manipulated on template 331*); and

saving, via said at least one network service, the composition document in the personal imaging repository (*column 16:lines 28-34, saving is accomplished in repository, i.e. the artwork database 223 in fig 2, where, column 15:lines 34-43, the data is stored*).

Regarding claim 2, **Arledge et al.** teach the method of claim 1, wherein said receiving user input comprises receiving user input that causes the imaging data to be arranged on the composition document (*column 16:lines 13-19, composition document is manipulated/arranged on template 331*);

Regarding claim 3, **Arledge et al.** teach the method of claim 1, wherein said receiving user input comprises receiving user input that causes the imaging data to be manipulated on the composition document (*column 16:lines 13-19, composition document is manipulated/arranged on template 331*).

Regarding claim 7, **Arledge et al.** teach the method of claim 1, wherein said receiving user input comprises receiving user input that causes the imaging data to be manipulated on the composition document by causing at least a portion of the imaging data to be presented on a printed composition document in a state that is different from a state in which the imaging data would have been presented on

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a printed page were the imaging data to have been printed prior to said receiving user input for incorporating the imaging data into the composition document (*in following the provision for data manipulation previously described in claims 1 & 3, the data in the composition document can be set in a different position than it is in its original document. Therefore it is present in a different state. Column 21:lines 47-57, document formatting is performed for printing*).

Regarding claim 8, **Arledge et al.** teach the method of claim 1, wherein said acts of causing, receiving user selection, receiving user input and saving are performed by multiple network services (*fig 1, network services are performed by client 101, web server computers 120/140, workflow management server computer 280 and preparation system 201*).

Regarding claim 9, **Arledge et al.** teach the method of claim 1, wherein said at least one network service is implemented, at least in part, by at least one printer (*the network service of receiving user input for incorporating image data into the composition document is implemented in part by the printer because it received the document with the user input. Column 21:lines 47-57, document formatting is performed for printing, which requires a printing network service*).

Regarding claim 10, **Arledge et al.** teach the method of claim 1, wherein said at least one network service is implemented, at least in part, by at least one proxy server that serves as a proxy for at least one printer (*fig 1, LAN server 112 acts as a proxy for all clients, wherein it has the authority to control traffic between clients and the Internet*).

Regarding claim 11, **Arledge et al.** teach one or more computer-readable media having stored thereon computer-readable instructions (*column 10:lines 6-66, workflow management server computer 280 with suitable hardware*) which, when executed by one or more processors, cause the processors to:

send content to a client device (*fig 1, client 101, & column 7:line 62 – column 8:line 30, client 101 communicates via sent content*), said content enabling the client device to:

display a user interface (*fig 10, layout tool applet window 330*) that is configured to enable a user to select imaging data from a personal imaging repository (*column 16:lines 7-12, user selects data available in system from list of list of documents in repository*);

provide, over a network, a user selection of imaging data from the personal imaging repository (*column 16:lines 7-12, user selects graphic images and art work uploaded by the user's computer to the repository*);

provide, over the network, user input for incorporating the imaging data into a composition document (*column 15:lines 63-64, a desired design layout is defined, and, column 16:lines 7-19, data on repository selected to be added to layout & column 16:lines 13-19, composition document is manipulated on template 331*).

Regarding claim 12, **Arledge et al.** teach one or more computer-readable media as recited in claim 11, wherein the instructions further cause the one or more processors (*fig 1, CPU 121/141*) to save, via the network, the composition document in the personal imaging repository (*column 16:lines 28-34, saving is accomplished in repository, i.e. the artwork database 223 in fig 2, where, column 15:lines 34-43, the data is stored*).

Regarding claim 13, **Arledge et al.** teach one or more computer-readable media as recited in claim 11, wherein the instructions further cause the one or more processors (*fig 1, CPU 121/141*) to print, via the network, the composition document on one or more network accessible printers (*fig 22, item 4 on document 145e describes print of customer documents, which inherently requires means for printing*).

Regarding claim 14, **Arledge et al.** teach one or more computer-readable media as recited in claim 11, wherein the instructions further cause the one or more processors (*fig 1, CPU 121/141*) to provide said user selection and said user input over a network comprising the Internet (*fig 1, Internet 50*).

Regarding claim 15, **Arledge et al.** teach a method comprising:

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causing, via at least one Web service (*column 7:lines 30-32, web service to include multiple services*), a user interface (*fig 10, layout tool applet window 330*) to be presented on a client device (*fig 1, client 101*), the user interface being configured to enable a user to select imaging data from a Web-accessible personal imaging repository (*column 16:lines 7-12, user selects graphic images and art work uploaded by the user's computer to the repository*);

receiving, via said at least one Web service, a user selection of imaging data from the personal imaging repository (*column 16:lines 7-12, user selects data available in system from list of list of documents in repository*);

receiving, via said at least one Web service (*fig 10 7 column 15:lines 49-51, "realtime" design layout applet*), user input for incorporating the imaging data into a composition document (*column 15:lines 63-64, a desired design layout is defined, and, column 16:lines 7-19, data on repository selected to be added to layout & column 16:lines 13-19, composition document is manipulated on template 331*); and

saving, via said at least one Web service, the composition document in the personal imaging repository (*column 16:lines 28-34, saving is accomplished in repository, i.e. the artwork database 223 in fig 2, where, column 15:lines 34-43, the data is stored*).

Regarding claim 16, **Arledge et al.** teach the method of claim 15, wherein said receiving user input comprises receiving user input that causes the imaging data to be arranged on the composition document (*column 16:lines 13-19, data is manipulated by user input*).

Regarding claim 18, **Arledge, Jr. et al.** teach the method of claim 15, wherein said receiving user input comprises receiving user input that causes the imaging data to be manipulated on the composition document by causing at least a portion of the imaging data to be presented on a printed composition document in a state that is different from a state in which the imaging data would have been presented on a printed page were the imaging data to have been printed prior to said receiving user input for incorporating the imaging data into the composition document (*in following the provision for data*

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*manipulation previously described in claims 15 & 16, the data in the composition document can be set in a different position than it is in its original document. Therefore it is present in a different state. Column 21:lines 47-57, document formatting is performed for printing)*

Regarding claim 19, **Arledge, Jr. et al.** teach a method comprising:

causing, via at least one network service (*column 7:lines 30-32, web service*), a user interface (*fig 10, layout tool applet window 330*) to be presented on a client device (*fig 1, client 101*), the user interface being configured to enable a user to select imaging data from a personal imaging repository (*column 16:lines 7-12, user selects graphic images and art work uploaded by the user's computer to the repository*);

receiving, via said at least one network service, a user selection of imaging data from the personal imaging repository (*column 16:lines 7-12, user selects data available in system from list of documents in repository*);

receiving, via said at least one network service (*fig 10 7 column 15:lines 49-51, "realtime" design layout applet*), user input for incorporating the imaging data into a composition document, said user input causing one or more of (1) the imaging data to be arranged on the composition document, and (2) the imaging data to be manipulated on the composition document (*column 15:lines 63-64, a desired design layout is defined, and, column 16:lines 7-19, data on repository selected to be added to layout & column 16:lines 13-19, composition document is manipulated on template 331*); and

printing, via said at least one network service, the composition document on one or more network-accessible printers (*in following the rejection of claim 32, the web service is responsible for printing, therefore the printer is web-accessible through the service*).

Regarding claim 20, **Arledge, Jr. et al.** teach the method of claim 19, wherein at least one of said at least one network services is implemented, at least in part, by at least one printer (*the network service of printing is implemented on the printer. Column 21:lines 47-57, document formatting is performed for printing, which requires a printing network service*).



Regarding claim 25, **Arledge, Jr. et al.** teach a graphical user interface (*fig 10, layout tool applet window 330*) comprising:

a document arrangement portion (*fig 10, ADD ART button 332b*) configured to enable a user to select one or more documents from a Web-accessible personal imaging repository (*column 16:lines 7-12, user selects data available in system from list of list of documents in repository*);

a document preview window (*fig 10, layout tool field 333*) configured to enable a user to view iconic representations of one or more pages of the one or more documents (*column 16:lines 7-12, layout tool field 333 includes a list, i.e. iconic representations of all available data for selection and insertion into the composition document, wherein the icon data representation is associated by the amount of pages that has been saved for each document*);

a selected documents portion (*fig 10, layout tool field 333*) that enables a user to view iconic representations of the one or more documents (*column 16:lines 7-12, layout tool field 333 includes a list, i.e. iconic representations of all available data for selection and insertion into the composition document*).

Regarding claim 26, **Arledge, Jr. et al.** teach the graphical user interface of claim 25 further comprising a preview portion configured to enable a user to toggle the document preview window between a representation of a physical page that the user is creating and one or more other pages that the user is using to create the physical page (*fig 10 & column 16:lines 13-16, buttons 334a-d allow toggle between data used to create the composition document and the entire composition document as one piece*).

Regarding claim 27, **Arledge, Jr. et al.** teach the graphical user interface of claim 25 further comprising means (*fig 10, buttons 332*) for presenting one or more manipulation operations that can be selected by a user for application to one or more of the selected documents (*fig 10 and column 16:lines 13-19, tools are provided in user interface to provide manipulation operations selectable by user*).

Regarding claim 29, **Arledge, Jr. et al.** teach a web service (*column 7:lines 30-32, internet/web system/service*) comprising:

means (*fig 10, ADD ART button 332b*) for enabling a user to access one or more documents from a Web-accessible personal imaging repository that is associated with the user (*column 16:lines 7-12, user selects data available in system, wherein, column 15:lines 34-43, the data is associated with user's account*);

means (*fig 10 7 column 15:lines 49-51, "realtime" design layout applet*) for enabling the user to arrange one or more documents or portions thereof to define a composition document (*column 15:lines 63-64, a desired design layout is defined, and, column 16:lines 7-19, data on repository selected to be added to layout*); and

means (*fig 10, custom printed product template 331*) for enabling the user to manipulate portions of the composition document (*column 16:lines 13-19, composition document is manipulated on template 331*).

Regarding claim 30, **Arledge, Jr. et al.** teach the web service of claim 29 further comprising means (*fig 10, DONE button 336*) for saving the composition document (*column 16:lines 28-32, once design and layout is complete, DONE button is selected and the document is saved*).

Regarding claim 31, **Arledge, Jr. et al.** teach the web service of claim 29 further comprising means for saving the composition document in the personal imaging repository (*column 16:lines 28-34, saving is accomplished in repository, i.e. the artwork database 223 in fig 2, where, column 15:lines 34-43, the data is stored*).

Regarding claim 32, **Arledge, Jr. et al.** teach the web service of claim 29 further comprising means for printing the composition document (*fig 22, item 4 on document 145e describes print of customer documents, which inherently requires means for printing*).

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Regarding claim 33, **Arledge, Jr. et al.** teach the web service of claim 29 further comprising means for printing the composition document on one or more Web-accessible printers (*in following the rejection of claim 32, the web service is responsible for printing, therefore the printer is web-accessible through the service*).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 4-5 & 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arledge, Jr. et al. (US 6 535 294) & Yamada et al. (US 6 570 678).**

Regarding claims 4 & 21, **Arledge, Jr. et al.** teach the method of claims 1 & 19, but do not teach wherein said receiving user input comprises receiving user input that causes the imaging data to be manipulated on the composition document by causing at least a portion of the imaging data to appear rotated on the composition document when the composition document is printed.

However, **Yamada et al.** teach (*column 3:lines 30-31*) teach the desired rotation of an image.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the rotation method taught by **Yamada et al.** in the method/apparatus taught by **Arledge, Jr. et al.** because both relate to image production methods, and the rotation option allows for greater functionality.

Regarding claims 5 & 22, **Arledge, Jr. et al.** teach the method of claims 1 & 19, respectively, but do not teach wherein said receiving user input comprises receiving user input that causes the imaging data to be manipulated on the composition document by causing at least a portion of the imaging data to appear scaled on the composition document when the composition document is printed.

However, **Yamada et al.** teach wherein said receiving user input comprises receiving user input that causes the imaging data to be manipulated on the composition document by causing at least a portion of the imaging data to appear scaled on the composition document when the composition document is printed (*column 1:lines 23-30, editing of image can be done using scaling*).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the rotation method taught by **Yamada et al.** in the method/apparatus taught by **Arledge, Jr. et al.** because both relate to image production methods, and the scaling option allows for greater functionality.

**Claims 6, 17, 23, 24, & 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arledge, Jr. et al. (US 6 535 294) & Cyman, Jr. et al. (US 5 845 302).**

Regarding claims 6 & 23, **Arledge, Jr. et al.** teach the method of claims 1 & 19, respectively, but do not teach wherein said receiving user input that causes the imaging data to be manipulated on the composition document comprises receiving user input that causes at least a portion of the imaging data to appear translated on the composition document when the composition document is printed.

However, **Cyman, Jr. et al.** teach a user interface that assigns tags to the composition document, wherein the tags are translated prior to printing (*column 10:lines 14-17*).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the tags taught by **Cyman, Jr. et al.** in the graphical user interface taught by **Arledge, Jr. et al.** because they are from the same field of endeavor i.e. document formatting and formation, and the translation method adds additionally functionality of a formatting method.

Regarding claims 17, 24 & 28, **Arledge Jr., et al.** teach the method, method and graphical user interface of claims 15, 19 & 25, respectively, but do not teach wherein said receiving user input that causes the imaging data to be manipulated on the composition document comprises receiving user input that causes at least a portion of the imaging data to appear at least one of (1) rotated, (2) scaled, and (3) translated on the composition document when the composition document is printed.

However, **Cyman, Jr. et al.** teach a user interface that assigns tags to the composition document, wherein the tags are translated prior to printing (*column 10:lines 14-17*).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the tags taught by **Cyman, Jr. et al.** in the graphical user interface taught by **Arledge, Jr. et al.** because they are from the same field of endeavor i.e. document formatting and formation, and the translation method adds additionally functionality of a formatting method.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Pendergrass whose telephone number is (571) 272-7438. The examiner can normally be reached on Monday-Friday 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440.



**KING Y. POON  
PRIMARY EXAMINER**